

Remarks**1. Summary of the Office Action**

Claims 1-13 and 30-32 are pending, of which claims 1, 6, 10, and 12 are independent. In the Final Office Action ("OA") mailed November 21, 2005, the Examiner rejected each claim as unpatentable over U.S. Patent No. 6,892,354 ("Servan-Schreiber") in view of the "official notice" that both triggering events and stationary subscriber terminals are common knowledge in the telecommunications art.

2. Finality of the Office Action

The Examiner indicated that the November 21, 2005 OA was "made final" because "Applicant's amendment necessitated the new ground(s) of rejection." Applicant respectfully submits that the finality of the OA is improper because the amendment did not necessitate the new rejection.

Generally, under MPEP 706.07(a), a final rejection may not accompany a new grounds for rejection unless the case falls within an exception – such as when the new grounds for rejection were necessitated by a claim amendment. Here, Applicant's claim amendments did not serve to distinguish the claimed invention from the cited art ("Blacketter") and thus did not necessitate the new grounds for rejection. Rather, Blacketter was distinguished from the claims based on elements that were present in the claims as originally filed.

Applicant's amendment included three limitations: "telecommunications network," "subscriber terminal," and "computer readable" memory. However, prior to the amendments, other claims already included a "subscriber terminal," "communications network," and "memory." Likewise, the Blacketter reference included "semiconductor memory", "packet-

switched network", and "internet terminal." In Applicant's arguments, these elements were not used to distinguish the claims from the cited art.

Because the amendment was (1) not used as a basis for distinguishing from the previously cited art; and (2) only introduced limitations that were already present in other claims or that were in the previously cited art, the amendment did not necessitate the new grounds of rejection. Thus, Applicant submits that the action was improperly made final and respectfully requests that the finality be removed.

Additionally, Applicant submits that the Examiner's reliance on "official notice" in the present OA warrants removal of the finality under MPEP 2144.03, which states that assertion of "official notice" "should be rare when an application is under final rejection." This is because, under MPEP 2144.03, the applicant should "be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." Unfortunately, a final OA does not provide adequate opportunity for an applicant to challenge the common knowledge assertion.

3. Response to § 103 Rejection of Claims 1-13 and 32-34

The Examiner rejected claims 1-13 and 30-32 as unpatentable over U.S. Patent No. 6,892,354 ("Servan-Schreiber") in view of the "official notice" that triggering events and stationary subscriber terminals are common knowledge in the telecommunications art. Under MPEP § 2143, a prima facie case of obviousness can be established only if the cited prior art teaches or suggests all of the claim limitations. Applicant respectfully traverses the obviousness rejections of the claims because Servan-Schreiber in view of the aforementioned official notice fails to disclose or suggest every element of any of these claims. In addition, although Applicant agrees that triggers and subscriber terminals have been used in the telecommunications industry,

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the Examiner has not identified any teaching or suggestion of either triggers or subscriber terminals used in a manner that teaches or suggests those limitations in the claims.

a) The Claimed Invention

Applicant's independent claim 1 is directed to a method of advertising on a subscriber terminal. As recited in claim 1, an advertising authorization request is sent to the subscriber terminal via an electronic communications network. Then, a reply to the authorization request is received from the subscriber terminal – the reply including an authorization for an advertisement to be sent to the subscriber terminal. In response to the authorization, the advertisement is sent to the subscriber terminal after a triggering event occurs.

Independent claims 6 and 12 include the authorization request and/or reply and also require displaying the advertisement on the subscriber terminal when at least one triggering event occurs.

Further defining the authorization, dependent claims 3 and 8 provide that the advertising authorization request includes a “user-selectable option” for authorizing an advertisement.

Dependent claims 2, 7, and 11 further define the triggering event as either the subscriber terminal being idle or the subscriber terminal being substantially stationary. Dependent claims 5 and 9 further limit the method by defining the triggering event as when the subscriber terminal is *both* idle *and* substantially stationary.

b) The Servan-Schreiber Reference

Servan-Schreiber provides a disclosure of a method of on-line advertising that operates by downloading and storing advertising data. When the user makes a request to retrieve new data (such as by following a hyperlink) the advertising data is displayed while awaiting download of the new data. The advertisement remains displayed while the connection to a

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remote server is made and at least until a portion of a new content data is transmitted to the user terminal. (See, Servan-Schreiber, Abstract).

c) Servan-Schreiber Does Not Teach Or Suggest An Advertising Authorization Request Or An Ensuing Reply

Each independent claim of the present invention includes sending an advertising authorization request to a subscriber terminal and/or receiving (or retrieving) a reply to the advertising authorization request. Generally the advertising authorization is used to determine whether an advertisement may be sent to the subscriber terminal. These authorizations provide a mechanism to help ensure that unauthorized advertisements, such as SPAM, are not sent to the subscriber terminal.

Neither the authorization request nor the reply are disclosed or suggested by Servan-Schreiber. Rather, Servan-Schreiber assumes that an advertisement will be sent in every instance. For example, Figure 2 of Servan-Schreiber, the only flow diagram provided in the reference, shows that ad data is downloaded as a matter of consequence at step 34. *In Servan-Schreiber, there is no suggestion to determine whether an advertisement would be authorized by the subscriber terminal.*

Because Servan-Schreiber does not teach or suggest sending an advertising authorization request to a subscriber terminal and/or receiving (or retrieving) a reply to the advertising authorization request, Servan-Schreiber cannot obviate any of the independent claims or their dependents.

d) Servan-Schreiber Does Not Teach Or Suggest A "User-Selectable Option" For Authorizing An Advertisement.

Dependent claims 3 and 8 further define the authorization portion of the claimed methods. Specifically, the claims provide that the advertising authorization request sent to the

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subscriber terminal includes a "user-selectable option" for authorizing an advertisement. In practice, the user-selectable option may allow a human user of the subscriber terminal to determine whether or not to receive the advertisements.

Servan-Schreiber does not provide any suggestion of a functionality for allowing a user of a subscriber terminal to select an option to authorize the advertisement. As such, dependent claims 3 and 8 provide subject matter that is patentable over Servan-Schreiber.

e) The Prior Art Does Not Teach or Suggest the Claimed Triggering Event

Dependent claims 2, 7, and 11 define the triggering event as occurring when the subscriber terminal is *either idle or substantially stationary*. Dependent claims 5 and 9 limit the method by defining the triggering event as occurring when the subscriber is *both idle and substantially stationary*. In contrast, the Examiner found that Servan-Schreiber does not include any triggering event, but then asserted that triggering events are common knowledge in the telecommunications industry.

Applicant respectfully asserts that neither Servan-Schreiber nor knowledge of triggering events generally teach or suggest the types of triggering events described in claims 2, 5, 7, 9, and 11 nor do they teach or suggest the particular uses of those types of triggering events in the delivery of advertisements.

As such, Servan-Schreiber cannot serve to obviate dependent claims 2, 5, 7, 9, or 11.

4. Conclusion

In view of the above remarks, Applicant respectfully requests reconsideration and allowance of all the pending claims. Should the Examiner have any questions, the Examiner is invited to contact the undersigned attorney at his direct dial number (312) 913-3316.

Respectfully submitted,

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